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In the Supreme Court of the United States

OCTOBER TERM, 1949.

No. 409.

THE MIDLAND STEEL PRODUCTS COMPANY,
Petitioner,

vs.

CLARK EQUIPMENT COMPANY,
Respondent.

REPLY BRIEF IN SUPPORT OF PETITION FOR WRIT OF CERTIORARI.

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We have no quarrel with the rule stated by this Court in *Merrill-Ruckgaber v. U. S.*, 241 U. S. 378. In that case there was an ambiguity in a section of the contract and it was perfectly proper to go to other portions of the contract for an interpretation. This is very clear from the statement of the Court as follows:

> "*If we may concede to appellant an ambiguity* in the specifications, arising from the use of the singular word 'building,' instead of the plural word 'buildings,' against the material conditions which appellant's officers had inspected and knew of, and against, as well, *the other parts of the specifications*, which, among other things, call for 'rear walls' instead of a 'rear wall,' seemingly implying two buildings, and not one only, at the utmost it could only be said that there was ground for dispute, and, under the contract, the decision of the architect upon the dispute was final." (Emphasis ours.)

We think the emphasized portions alone show that this was a case where there was an ambiguity in one section of

the contract and resort was to be had to other portions to clear up the ambiguity.

No such situation exists in the case at bar.

The rule where a patent claim is not ambiguous was stated by this Court in *Graver v. Linde Air*, 336 U. S. 217, as follows (93 Law Ed. Advance Opinions p. 496):

> "It would accomplish little to require that claims be separately written if they are not to be separately read." *

There is no evidence in this cause that any of the claims presented by the Petition for Certiorari are ambiguous. The statement relied upon by Respondent, quoted from the opinion of the Court of Appeals and appearing at the top of page 8 of Respondent's Brief, is not evidence of ambiguity. At most it is a further resort by the Court of Appeals to extraneous matter to interpret an unambiguous claim. Indeed, it is a second resort to the specification for that purpose since the Court either went to the specification to determine what the Court thought to be the inventor's fundamental idea or else went beyond the four corners of the patent to do so.

Moreover, even if this expression were construed to be a finding of ambiguity and that was sufficient to establish

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* In view of the very clear statement of the general rule of construction of parts of contracts in these two decisions of this Court, it seems unnecessary for us to go through and point out the facts in each of the many decisions cited at pages 6 and 7 of Respondent's Brief. Either these decisions fall on one side or the other of this rule, or else they show the existence of the very confusion on this subject which is one of the salient and dominant reason for this Court settling the matter. In other words, if these decisions are authority for going to the specification to interpret an unambiguous claim, then they are contrary to the rule of contracts, the rule in the British Courts, the rule in this Court and the rule in the Fifth Circuit. If so, they are commanding reasons for settling the question here presented. If the claims in those cases were ambiguous and, therefore, resort is had to the specification, they are immaterial here, just as this Court's decision in *Merrill-Ruckgaber v. U. S., supra*, is immaterial.

ambiguity, it would apply only to the method claims. Of the claims before this Court the following are apparatus claims to which it would not apply:

Claims 4, 8 and 16 of Patent No. 2,139,771,
Claim 7 of Patent No. 1,948,801, and
Claims 26 and 30 of Patent No. 2,061,671.

The claims listed in the section numbered (1) on page 3 of our Main Brief are not involved here since these were the ones that recite the full depth limitation. It is manifest that the Court below did not consider that the prior art forced a limitation on the other claims since the Court went to the specification to find a justification in the Court's mind for reading this limitation into the claims listed in sections (2), (3) and (4) on page 3 of our Main Brief.

The prior art can no more be resorted to to construe an unambiguous claim than the specification of the patent. The rule is that an unambiguous section of a contract must be interpreted within its own four corners. Indeed, resort to prior art to construe an unambiguous claim is even more remote and a more flagrant violation of the rule than resort to the specification which this Court said could not be done in *Graver v. Linde Air, supra.** If the Court of Appeals had thought the claims recited in sections (2), (3) and (4) at page 3 of our Main Brief were anticipated by the prior art, such would no doubt have been the Court's pronouncement. However, the Court did not think so and, therefore, went to the specification to read or construe the limitation into the unambiguous claims to establish non-

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* In *Wayne v. Humble*, 175 Fed. (2) 230 (CCA 5) the Court there refused to do just what Respondent asserts the Sixth Circuit Court of Appeals did here, i.e., the Fifth Circuit Court of Appeals refused to read or construe a limitation in the unambiguous claims to save them from the prior art. Thus Respondent points to a second diversity of decision relating to an important principle of patent law existing here between these Circuits. In the instant cause the claims could not be held invalid, as in the Fifth Circuit case, because of the estoppel to deny validity, and hence the reading or construing of the limitation into the claims.

infringement, all in diversity with the rule in the Fifth Circuit which is supported by the general rule of contracts, the rule followed in the British Courts, as we pointed out at pages 8 and 9 of our Main Brief.

The forepart of Respondent's Brief is replete with errors apparently presented as red herrings; all these are immaterial to the single and simple issue here. Only one merits mention. The Court of Appeals said it refused to extend the doctrine of equivalents to include the prior art with respect to the claims not included in this Petition (i.e., those included in section (1), p. 3 of our Main Brief). Whether the Court of Appeals was correct or not is immaterial here since those claims are not at issue here and the claims included in our Petition differ from the prior art in other particulars, hence the Court of Appeals read or construed into the latter group the full depth seam and melting "in the light of the specification" to create a non-infringing limitation; the propriety, or impropriety, of doing so, in view of the diversity of views on the subject in the Circuits, is the issue here.

We think Respondent's Brief is very helpful in showing the confusion which exists on this subject and the great need of settling the question by this Court once and for all, i.e., the question of whether or not a patent, which is recognized to be a contract, comes within the rule of contracts to the effect that an unambiguous section of the contract may not be varied or interpreted in the light of matter extraneous thereto, even though it be some other section of the contract.

Respectfully submitted,

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